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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,248	05/11/2001	Michael Salgaller	020093-000810US	7931

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EXAMINER

EWOLDT, GERALD R

ART UNIT	PAPER NUMBER
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1644

DATE MAILED: 09/25/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/854,248

Applicant(s)

Salgaller et al.

Examiner

G.R. Ewoldt, Ph.D.

Art Unit

1644



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 15, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above, claim(s) 1-9, 15, and 22-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-14 and 16-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's election of Group II, and the species: PSM-P1 (SEQ ID NO:1), in Paper No. 8, filed 7/15/03, is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 1-9 and 22-35 are withdrawn from further consideration by the Examiner, under 37 C.F.R. § 1.142(b) as being drawn to nonelected inventions. Claim 15 is withdrawn from further consideration by the Examiner, under 37 C.F.R. § 1.142(b) as being drawn to a nonelected species.

Claims 10-14 and 16-21 are being acted upon.

3. Claims 16-18 and 20 are objected to for the use of the past tense as regards the dendritic cells (DCs) of the claims, i.e., "dendritic cells were ..." of the claims. Claims are generally written in the present tense, i.e., "dendritic cells are ...".

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 10, 12-14, and 16-21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Under *Vas-Cath, Inc. v. Mahurkar*, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991), to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed.

There is insufficient written description to show that Applicant was in possession of "a factor or agent that promotes Major Histocompatibility Complex-(MHC-) class I processing of the

antigen", other than BCG. The specification fails to define or disclose any additional said factors or agents. Given the unexpected functional nature of the "factor or agent" (BCG) in the claimed invention, a reasonably representative number of said factors or agents would be required to support a generic claim. Given the lack of said disclosure, one of skill in the art must conclude that the specification fails to disclose an adequate written description of the claimed genus. See *Eli Lilly*, 119 F.3d 1559, 43 USPQ2d 1398.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 10-14 and 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,788,963 (1998, IDS) in view of Ramoner et al. (1998, IDS).

The '963 patent teaches a method for producing a tumor cell proliferation inhibiting response comprising administering to a patient an effective amount of human DCs, said DCs having been exposed *in vitro* to the prostate tumor associated antigenic fragment PSM-P1 (SEQ ID NO:1). The reference further teaches that the DCs are obtained from peripheral blood, have been cryopreserved, have been obtained from a healthy HLA matched donor, are extended life span, and can be administered to a metastatic prostate cancer patient (see particularly the Claims).

The reference teaching differs from the claimed invention only in that it does not teach the use of BCG in the *in vitro* exposure of the DCs to antigen.

Ramoner et al. teaches that BCG "is a potent activator of human DCs." The reference further teaches that BCG stimulates the ability of DCs to activate T cells. The reference further teaches that BCG could be used in DC based tumor immunotherapy (see particularly page 1491, CONCLUSIONS).

It would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to perform a method for producing a tumor cell proliferation inhibiting response comprising administering to a patient an effective

amount of human DCs, said DCs having been exposed *in vitro* to the prostate tumor associated antigenic fragment PSM-P1 (SEQ ID NO:1), said DCs having been obtained from peripheral blood, having been cryopreserved, having been obtained from a healthy HLA matched donor, having been extended life span, and having been administered to a metastatic prostate cancer patient, as taught by the '963 patent. One of ordinary skill in the art would have been motivated to add BCG to the *in vitro* exposure of said DCs because BCG "is a potent activator of human DCs", BCG stimulates the ability of DCs to activate T cells, and BCG could be used in DC based tumor immunotherapy, as taught by Ramoner et al.

8. No claim is allowed.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Gerald Ewoldt whose telephone number is (703) 308-9805. The examiner can normally be reached Monday through Thursday from 7:00 am to 5:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.



G.R. Ewoldt, Ph.D.
Primary Examiner
Technology Center 1600
September 22, 2003